

REMARKS

Reconsideration and withdrawal of the rejections set forth in the Office Action dated September 12, 2003, are respectfully requested. A separate petition for a one-month extension of time accompanies this amendment.

The attorneys for the applicant wish to thank the Examiner for the thorough Office Action, including the specific citations to portions of the applied references and the elements of the claims to which those portions relate.

I. Disclosed Embodiments of the Invention

Embodiments of the invention are directed to a system that receives telephone calls or other continuous information streams, where these streams include spoken address information. The spoken address information can include various electronic addresses, such as telephone numbers, email addresses, Uniform Resource Identifiers (URI), and so forth. Thus, as opposed to existing "voice dial" systems, whereby a user of a mobile phone may enter a special mode and audibly voice commands including phone numbers, embodiments of the invention monitor an ongoing voice stream (live or recorded) to identify electronic addresses. Once identified, embodiments of the invention extract or convert these recognized electronic addresses into a format so that they may be used automatically. For example, they may be converted into an alphanumeric string and made available to a user of a portable communication device, who may then provide user input (e.g., to press the " * " button) to quickly connect to some external device associated with that electronic address. In one embodiment, the component for recognizing such spoken address information in a continuous stream is located external to the portable communication device, but coupled to that device via a network.

II. The Applied Art

US Patent No. 6,526,929 to Henry, Jr. ("*Henry, Jr.*") is directed to a traditional voice dialing system for use with a portable phone. *Henry, Jr.* discloses a system for creating digit strings, for use by a phone, from speech data that includes numeric digits

and/or alphabetical characters. A specifically designed operating mode is enabled initially by the user to enter such a voiced dialing data. Column 3, lines 57-60. The phone then receives speech data that includes discrete numerical digits and/or alphabetic characters. See, e.g. column 4. The system of *Henry, Jr.* receives speech data command and determines whether it is a recognized digit, and if not, whether it is a recognized alphabetical character. If it is an alphabetical character, then it simply employs a look up table to convert that alphabetical character to a corresponding digit (e.g., characters "a," "b," and "c," corresponding to digit "2," "character d," "e," and "f," corresponding to digit "3," and so forth). A digit string is constructed and stored in volatile memory by use by the telephone. Column 4, line 46-Column 5, line 26.

US Patent No. 6, 073,103 to Dunn et al. (*Dunn et al.*) is directed to a display accessory for a record playback system whereby a time scale representing elapsed time for play out of an audio message or recording is provided. The system detects when specific sequences of sound occur in a message or recording and displays symbols alongside a time scale representing such sound sequences. In a voicemail system, a display of numbers recognized in a voicemail message are depicted at appropriate time intervals during a full duration of the message.

II. Rejections under 35 U.S.C. § 102

Distinctions between claim 12 and *Henry, Jr.* will first be discussed, followed by distinctions between *Henry, Jr.* and the remaining independent claims.¹

As noted above, *Henry, Jr.* discloses a typical voice dialing system. Such a system need only parse discrete spoken segments, and differentiate between such segments, namely individual digits or alphabetic characters. *Henry, Jr.* fails to disclose automatically recognizing and extracting telephone numbers from continuous voice streams. Claim 12, as previously pending, recited, among other limitations, a method

¹ Silence regarding the position taken, or argument made, by the Examiner does not indicate any acquiescence to that position or argument.

for automatically recognizing and extracting electronic addresses from received "voice streams." This is in contrast to discrete spoken commands or digits/characters. For at least this reason, the applicant believes claim 12 is patentable over *Henry, Jr.* However, claim 12 has been amended to clarify the inherent language of previously pending claim 12. In other words, claim 12 has been amended to recite, among other limitations, that the method includes automatically recognizing and extracting electronic addresses wherein "the voice streams are continuous, as opposed to discrete, streams of voice information." Such voice streams may be either live telephone calls or recorded voice messages. *Henry, Jr.* discloses only receiving live speech from a user.

Further, *Henry, Jr.* requires the mobile phone to enter into a special mode to receive such spoken digits/characters. *Henry, Jr.* fails to disclose the ability to recognize and extract electronic addresses from standard voice streams or ongoing telephone calls. Again, claim 12, previously pending, recited such a feature. However, claim 12 has been amended to clarify such an inherent aspect, namely that the method of automatically recognizing and extracting electronic addresses occurs "during normal reception of the voice stream and not under a special mode." For at least this additional reason, claim 12 is patentable over *Henry, Jr.*

Moreover, *Henry, Jr.* discloses only the automatic recognition of digits strings as telephone numbers, or certain phone commands (dial, store, edit, clear, pause, wait for key input, volume control, and display). Column 3, lines 51-53. *Henry, Jr.* fails to disclose or teach of automatically recognizing, in voice streams, email addresses or Uniform Resource Identifiers. Claim 12 has been amended to include such limitations. For this further reason, claim 12 is patentable over *Henry, Jr.*

Yet another distinction exists between the disclosure of *Henry, Jr.* and the invention of claim 12. *Henry, Jr.* describes a process performed on a mobile phone. Claim 12 has been amended to clarify that the method of automatically recognizing is performed at neither of two electronic communication devices. Thus, the method of claim 12 may be performed at an adjunct, or any component within a network, besides two electronic communication devices such as two phones.

As is known, to anticipate a claim under 35 U.S.C. § 102, the reference must teach every element of the claim.² *Henry, Jr.* fails to disclose every limitation recited in claim 12. Thus, for at least these reasons, claim 12 is patentable over *Henry, Jr.*

The remaining independent claims are allowable for similar reasons. Claim 1 recites a method, wherein the method includes, among other limitations, that voiced address information is received and identified in a telephone call. This is in contrast to *Henry, Jr.*, whereby spoken information cannot be received during a call, but must instead be received under a special mode. Further, a telephone call represents a continuous stream of audible information that includes within it voiced address information; *Henry, Jr.* processes only single discrete commands, digits or characters. Claim 16 now recites that received verbal data is "substantially continuous," in that the recited portable telephone system identifies spoken address information among the substantially continuous verbal data. Claim 19 recites similar limitations, and further recites that the electronic address includes not only telephone numbers but also email addresses or Uniform Resource Identifiers. Claim 21 has limitations similar to those discussed above. Overall, independent claims 1, 12, 16, 19 and 21 are allowable over *Henry, Jr.*

II. Rejections under 35 U.S.C. § 103

The Applied References Even if Combined, Fail to Disclose or Suggest the Claimed Invention.

As noted above, *Henry, Jr.* discloses a method whereby a mobile phone, in a special mode, receives individual spoken digits or alphabetic characters (that are to be

² MPEP section 2131, p. 70 (Feb. 2003, Rev. 1). See also, *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1462 (Bd. Pat. App. & Interf. 1990) (to establish a *prima facie* case of anticipation, the Examiner must identify where "each and every facet of the claimed invention is disclosed in the applied reference."); *Glaverbel Société Anonyme v. Northlake Mktg. & Supply, Inc.*, 45 F.3d 1550, 1554 (Fed. Cir. 1995) (anticipation requires that each claim element must be identical to a corresponding element in the applied reference); *Atlas Powder*

converted to digits). *Henry, Jr.* fails to disclose digit recognition in a voicemail message. *Dunn, et al.* discloses digit recognition in a recorded voicemail message. As explained below, *Henry, Jr.* and *Dunn et al.* would not be combined. However, even if they were combined, neither *Henry, Jr.* nor *Dunn et al.* teach or suggest extracting electronic address information in a continuous voice stream under a live telephone call. Claim 13 recites, among other limitations, the ability to receive both live calls and recorded information, where either one includes a "voice stream," namely a continuous stream of audible information. In other words, the invention of claim 13 includes recognizing spoken address information in live calls, which is not disclosed in either *Henry, Jr.* or *Dunn et al.*

Moreover, both *Henry, Jr.* and *Dunn et al.* require a special mode to process spoken digits/characters. In contrast, the invention of claim 13 performs such an analysis on live calls and recorded information where either one includes a voice stream from which identified address information is automatically recognized and extracted. Further, claim 13 recites a "recognition and connection system" that is distinct from other network components, namely a portable communication device.

Dunn et al. is directed to a client server computer system, while *Henry, Jr.* is directed to a portable phone. Claim 13 recites, among other limitations, not only a portable communication device and a voice message system, but also a routing system and at least one recognition and connection system. Neither *Henry, Jr.* nor *Dunn et al.* disclose a communication system as recited in claim 13. For at least the above reasons, claim 13 is patentable over *Henry, Jr.* and *Dunn et al.*

Claim 22 recites limitations similar to claim 13. Further, claim 22 recites that the means for automatically extracting extracts voiced address information that includes phone numbers and either email addresses or Uniform Resource Identifiers. As noted above, the applied references only disclose use of phone numbers. Thus, for similar and additional reasons, claim 22 is patentable over *Henry, Jr.* and *Dunn et al.*

Co. v. E.I. duPont De Nemours, 750 F.2d 1569, 1574 (1984) (the failure to mention "a claimed

Claim 22, in a manner similar to claim 13 (but different from claim 13) recites a portable communication device including means for connecting to external network components that include means for identifying voiced address information and means for automatically extracting the identified voiced address information. The invention recited under claim 22 makes clear that means external to the portable communication device performs the function of identifying the voiced address information and automatically extracting the identified voiced address information. This differs from the client-server computer system of *Dunn et al.*

The Applied References (1) Lack a Specific Suggestion to Combine Them As Argued in the Office Action, and (2) Fail to Identify the Problem of Increasing Impersonal Banking Interaction

Independent claims are allowable not only because they recite limitations not found in the references (even if combined), but for at least the following additional reasons. For example, there is no motivation to combine the various references as suggested in the Office Action. According to the Manual of Patent Examining Procedure ("MPEP") and controlling case law, the motivation to combine references cannot be based on mere common knowledge and common sense as to benefits that would result from such a combination, but instead must be based on specific teachings in the prior art, such as a specific suggestion in a prior art reference. For example, last year the Federal Circuit rejected an argument by the PTO's Board of Patent Appeals and Interferences that the ability to combine the teachings of two prior art references to produce beneficial results was sufficient motivation to combine them, and thus overturned the Board's finding of obviousness because of the failure to provide a specific motivation in the prior art to combine the two references.³ The MPEP provides similar instructions.⁴

element (in) a prior art reference is enough to negate anticipation by that reference").

³ In re Sang-Su Lee, 277 F.3d 1338, 1341-1343 (Fed. Cir. 2002).

⁴ Manual of Patent Examining Procedure, Section 2143 (noting that "the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure," citing in re Vaeck, 947 F.2d 488 (Fed. Cir. 1991)).

Conversely, and in a manner similar to that rejected by the Federal Circuit, the present Office Action lacks any description of a motivation to combine the references. Thus, if the current rejection is maintained, the applicant's representative requests that the Examiner explain with the required specificity where a suggestion or motivation in the references for so combining the references may be found.⁵

As is known, one may not use the application as a blueprint to pick and choose teachings from various prior art references to construct the claimed invention ("impermissible hindsight reconstruction").⁶ Assuming, for argument's sake, that it would be obvious to combine the teachings of *Henry, Jr.* and *Dunn et al.*, then *Henry, Jr.* would have done so because it would have provided at least some of the advantages of the presently claimed invention. *Henry, Jr.*'s failure to employ the teachings cited in *Dunn et al.* is persuasive proof that the combination recited to reject claim 13 is unobvious. Similar arguments apply to the other claims.

Moreover, an invention may be unobvious, even where all the elements are found in the prior art references, provided the references do not suggest the *advantage* to be gained by combining the references. *In re Sernaker*, the Federal Circuit stated that

[P]rior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings.⁷

None of the applied references appear to address the problem of, for example, receiving a continuous stream of voice data (either live or recorded) and automatically extracting electronic address data (phone numbers, email, URI), without the user requiring a special mode.

⁵ See, MPEP Section 2144.03.

⁶ See, e.g., *In re Gorman*, 933 F.2d 982,987 (Fed. Cir. 1991), ("One cannot use hindsight construction to pick and choose between isolated disclosures in the prior art to deprecate the claimed invention.").

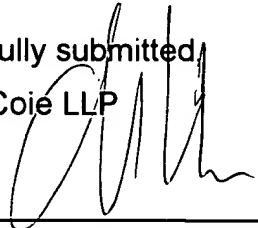
⁷ 217 U.S.P.Q. 1, 6-7 (Fed. Cir., 1983).

III. Conclusion

Overall, independent claims 1, 12, 13, 16, 19 and 21-22 are patentable over the applied references. Since these independent claims are allowable, based on at least the above reasons, the claims that depend from them are likewise allowable. If the undersigned attorney has overlooked a relevant teaching in any of the references, the Examiner is requested to point out specifically where such teaching may be found.

In view of the foregoing, the claims pending in the application comply with the requirements of 35 U.S.C. § 112 and patentably define over the applied art. A Notice of Allowance is, therefore, respectfully requested. If the Examiner has any questions or believes a telephone conference would expedite prosecution of this application, the Examiner is encouraged to call the undersigned at (206) 359-3599.

Respectfully submitted
Perkins Coie LLP



Christopher J. Daley-Watson
Registration No. 34,807

Correspondence Address:

Customer No. 30083
Perkins Coie LLP
P.O. Box 1247
Seattle, Washington 98111-1247
(206) 359-8000